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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,080

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Dragan Tomic

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EXAMINER

CHEN, TE Y

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,080

Applicant(s)

TOMIC ET AL.

Examiner

Susan Y. Chen

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2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 20-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/01/2003.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Response to Amendment

Election/Restrictions

Applicant's election of Group II (Claims: 8-12 and 20-36) in the reply filed on July 10, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant is reminded to cancel claims that are not elected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As set forth in MPEP 2106 (II) (A):

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claims 8-12 and 20-36, are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 8, this claim merely is a structure per se, which fails to provide concrete result, because the structure only stores XML instances when the claimed condition is matched, otherwise, the instant invention just hang-up there without bearing any concrete, tangible and useful result.

As to claim 20, this claim only recites functional steps, namely, when an XML instance is not conformed to any of the schema represented by the container, the claimed steps just hang-up there without producing any tangible, concrete and useful result.

As to claim 25, the claim is software per se, which again, fails to provide any concrete, tangible, useful result.

As to claim 31, the claimed abstract instruction means merely direct to abstract ideas that does not produce any concrete, tangible, useful result.

As to claims 9-12, 21-24 and 32-36, these claims have the same defects as their base claims, hence, are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-12 and 20-36, are rejected under 35 U.S.C. 102(e) as being anticipated by Arora et al. (U.S. Publication No. 2004/0002939)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Claim 8:

Arora et al. (hereinafter referred as Arora) disclose a data structure for containing Extensible Markup Language (XML) schema namespaces embodied in at least one computer readable medium [e.g., the edge table of XML storage solution processing of Abstract], comprising:

a container for XML schema namespaces [e.g., Fig. 5 and associated texts]; and at least two XML schema namespace universal resource identifiers (URIs) [e.g., Fig. 4 and associated texts]; whereby a storage location that is typed with said data structure for containing XML schema namespaces allows XML instances to be stored in the storage location only if validated according to an XML schema namespace identified by one of said at least two XML schema namespace URIs [e.g., col. 2, Sections: 0011-0012].

Claim 9:

Except the limitations recited in claim 8, Arora further discloses that the storage location is a column of a database [e.g., the Xpath column at Fig. 4].

Claim 10:

Except the limitations recited in claim 8, Arora further discloses that said container is used in conjunction with an import function which modifies said container containing two or more XML schema namespaces so that it refers to schema components in other XML schema namespaces [e.g., the portal or data aggregator technique at Sections: 0004 & 0040].

Claim 11:

Except the limitations recited in claim 8, Arora further discloses that said container contains two or more XML schema namespaces, and said container is used in

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conjunction with an include function which allows assembly of schema components for a single namespace from several schema documents [e.g. the use of foreign keys, indices and clustering techniques to include (or JOIN) data at Sections: 0042-0053].

Claim 12:

Except the limitations recited in claim 8, Arora further discloses that said container containing two or more XML schema namespaces is used in conjunction with an alter function which adds schema components to XML schema namespaces within said container containing two or more XML schema namespaces [e.g., the use of value-add technique at sections: 0054-0057].

As to claims 20-24, these claims recite the same features as claims 8-12 with different wording, hence, are rejected for the same reason.

As to claims 25-36, the claimed instructions and software means are deemed to be inherent by the functional steps as recited in claims 8-12 and 20-24, hence are rejected for the same reason.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

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Zwiegincew et al. (U.S. Publication No. 2004/0006563) which discloses manipulating schematized data in a database;

Kakivaya et al. (U.S. Publication No. 2003/0144849) which discloses an XML type level system and method for generalized and distributed scalable tasking system.

McConnell (U.S. Patent No. 6,996,571) which discloses XML storage solution and data interchange file format structure.

Sarkar (U.S. Patent No. 6,418,448) which discloses a system for processing markup language specifications for data and metadata used inside multiple related internet documents to navigate, query and manipulate information from a plurality of object relational databases over the web.

Points Of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

September 25, 2006

A handwritten signature in cursive script that reads "Susan Chen".